

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  1538US1.014033.018									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/707,327	Filed  December 5, 2003									
	First Named Inventor  Penny L. Gerstner										
	Art Unit  3691	Examiner  Bruce I. Ebersman									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding: 5px;">/r. brian drozd/ <hr style="border: none; border-top: 1px solid black; margin: 0;"/>Signature</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding: 5px;">R. Brian Drozd <hr style="border: none; border-top: 1px solid black; margin: 0;"/>Typed or printed name</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number 55,130</td><td style="vertical-align: top; padding: 5px;">919-286-8000 <hr style="border: none; border-top: 1px solid black; margin: 0;"/>Telephone number</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding: 5px;">March 24, 2010 <hr style="border: none; border-top: 1px solid black; margin: 0;"/>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/r. brian drozd/ <hr style="border: none; border-top: 1px solid black; margin: 0;"/> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	R. Brian Drozd <hr style="border: none; border-top: 1px solid black; margin: 0;"/> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 55,130	919-286-8000 <hr style="border: none; border-top: 1px solid black; margin: 0;"/> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	March 24, 2010 <hr style="border: none; border-top: 1px solid black; margin: 0;"/> Date
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<input type="checkbox"/> *Total of _____ forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/707,327 Confirmation No.: 1326  
Applicants: Penny L. Gerstner  
Filed: December 5, 2003  
Group Art Unit: 3691  
Examiner: Ebersman, Bruce I  
Title: SYSTEM AND METHOD FOR AUTHORIZING THIRD-PARTY  
TRANSACTIONS FOR AN ACCOUNT AT A FINANCIAL  
INSTITUTION ON BEHALF OF THE ACCOUNT HOLDER

Attorney's Docket: 1538US1.014033.018  
Customer Number: 69603

Mail Stop: AF  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicants submit that the current and preceding Office Actions issued by the Office in the present application contain clear errors in the Office's rejections as well as omissions of one or more essential elements needed for a *prima facie* rejection under 35 U.S.C. §§ 102 and 103.

**A. Final Office Action**

Claims 11-35 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 7,376,587 to Neofytides et al. ("Neofytides"). Claims 1-10 were rejected under 35 U.S.C. § 103 as obvious over Neofytides in view of U.S. Patent Application Publication No. 2003/0191711 to Jamison ("Jamison"). It is submitted that these rejections contain clear errors, as discussed below.

**B. Invention**

Embodiments of the present invention provide for methods and systems whereby a financial institution can collect, process, transmit and confirm authorizations to third parties for electronic payments and direct deposits on behalf of its account-holder customer. Through access to centralized authorizations through the financial institution, a customer can be relieved of much of the repetitive burden of contacting various third parties to arrange for or make changes to automatic draft payments and direct deposits. Such relief can be especially beneficial when a customer who makes extensive use of automatic payments and/or direct deposits changes financial institutions, or changes accounts within the same financial institution, as may be required if the security of the old account has been compromised. None of the cited art teaches such invention or even realizes the advantages thereof.

C. The 35 U.S.C. 102(e) Rejection of Claims 11-35 Is Clear Error

A claim is anticipated only if **each and every** element as set forth in the claim is found in the reference. See M.P.E.P. § 2131. All of Applicants' claims contain recitations not fairly taught or disclosed in Neofytides.

Independent Claims 11, 21 and 26 recite that one or more "specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of recurring third-party transactions on behalf of the account holder." Applicants can find no such teaching in the cited portions of Neofytides, but rather only a discussion of a one-time transfer of money from one person to another person. In the Office Action, column 1, line 57-column 2, line 2 of Neofytides were cited for teaching the above features of the independent claims. Column 2, lines 1-2 of Neofytides recites ". . . an individual may use the payment enabler to schedule future or recurring transactions." Accordingly, Neofytides only discloses that an account holder may schedule recurring transactions to be performed by his bank to a third party. However, Neofytides does not teach or suggest that the account-holder authorizes a *specific third party participant* to perform a plurality of recurring third-party transactions on behalf of the account holder. There is no disclosure in Neofytides of transactions that are performed by a *third party participant* on behalf of the account holder, much less a *request to authorize* such recurring transactions. Such features of independent Claims 11, 21 and 26 has not been taught or suggested in Neofytides. For a proper rejection under Section 102, the Examiner must demonstrate that the identical invention is "shown in as complete detail as contained in the....claim," and that the elements are "arranged as required by the claim...." See M.P.E.P. § 2131. Such burden has simply not been met.

Further, Claims 11, 21 and 26 recite "receiving account-holder requests, wherein specific requests from among to authorize the plurality of third-party transactions." In rejecting this recitation, the Examiner cited column 5, line 38-column 6, line 9 and stated "which discusses how a payor initiates debiting his/her bank account in an electronic monetary transaction." However, nowhere does Neofytides disclose receiving a request to authorize recurring third-party transactions, where the third-party is an entity other than the financial institution or the account-holder. There is certainly no disclosure that a financial institution receives such request to authorize a third party (other than the financial institution) to perform transactions.

Claims 11, 21 and 26 further recites "matching at least one specific request from among the account-holder requests to at least one specific third-party participant." In rejecting this recitation, the Examiner cited column 11, lines 62 - column 12, line 8 of Neofytides, which recites:

"In step 670, the payment enabler 170 poses the security question to the payee 130 and receives a response from the payee. In step 680, the payment enabler 170 determines if the response matches the expected answer to the security question that was entered by the payor 110 in step 640."

Accordingly, the above portion of Neofytides merely discloses posing a security question to the payee and receiving a response thereto. This response is not an account-holder request, much less an account-holder request to authorize third-party transactions.

Claims 11, 21 and 26 further recite “forwarding the at least one specific request to the at least one specific third-party participant on behalf of the account holder.” In rejecting this claim recitation, the Office cited column 11, lines 48-56 of Neofytides and stated “which discusses how a payor confirms the transaction.” This portion of Neofytides merely relates to a payee sending an email to a payor confirm payment. However, this confirmation “email” that was sent from the payee to the payor in Neofytides is not a “request,” much less the “at least one specific request” to “authorize recurring third party transactions,” as recited in claim 1. Further, the “email” is not sent “on behalf of the account-holder” nor to “the at least one specific third-party participant.”

Claims 11, 21 and 26 yet further recite “receiving, at the financial institution, at least one participant confirmation from the at least one specific third-party participant.” In rejecting this claim recitation, column 11, line 48 – column 12, line 8 of Neofytides was cited and the Office Action stated “which discusses how a payee confirms approval of an electronic money transfer.” However, there is no discussion of receiving any confirmation in this cited portion of Neofytides. Also, there is nothing received “at the financial institution.”

Additionally, Neofytides does not disclose receiving “a confirmation that the at least one specific third-party participant’s accounting system has been updated based on the at least one specific request,” as recited in Claims 11, 21 and 26. This is because Neofytides only deals with a one-time transfer of money from one person to another and not a plurality of recurring *third-party* transactions. In the Office Action, column 13, lines 4-13 and column 14, lines 20-27 was cited as allegedly teaching this feature of Claims 11, 21 and 26. However, Neofytides does not disclose a third party updating an accounting system. In fact, there is no mention whatsoever in Neofytides of any accounting system. Further, there is certainly no disclosure in Neofytides of a *confirmation* that the accounting system has been updated. In the previous Advisory Action, the Examiner cited column 9, line 52 – column 10, line 49 of Neofytides. However, this portion of Neofytides only relates to a user updating an address book. There is no disclosure of “at least one specific third-party participant’s accounting system” being updated. An address book cannot be reasonably interpreted as an accounting system. Additionally, updating the address book is done by the account holder and not by a third party. There is no confirmation discussed in Neofytides at all and there is certainly no disclosure in Neofytides of a confirmation based on at least one request by a third party to perform recurring transactions.

For at least the above-identified reasons, independent Claims 11, 21, and 26, as well as the claims dependent therefrom, are patentable over Neofytides and reconsideration and withdrawal of the Section 102 rejection of such claims is requested.

*D. The 35 U.S.C. 103(a) Rejection of Claims 1-10 Is Clear Error*

Claim 1 is allowable over Neofytides and Jamison, singly or in combination, for the same reasons as discussed above for Claims 11, 21 and 26. Jamison adds nothing to Neofytides to render Claim 1 unpatentable. Further, the Office Action acknowledges that “Neofytides does not explicitly disclose that a third-party is defined by ‘by a 3rd party entity other than the financial institution or account holder.’ ” See Page 10, Final Office Action. The Office Action instead relies on Jamison as teaching such recitation at paragraphs [0034], [0051], and [0084]. However, Jamison merely discloses a bill center which is capable of making payments on biller websites on behalf of customers. There is no disclosure that the bill center is other than the financial institution.

Further, there is no disclosure of “matching . . . at least one specific request from among the account-holder requests *to at least one specific third-party participant*,” “forwarding the at least one specific request *to the at least one specific third-party participant*,” or “receiving, at the financial institution, at least one participant confirmation *from the at least one specific third-party participant*.” The mere mention in Jamison that a third party can be an entity other than the account holder does not teach or suggest the above-specific recitations of independent Claim 1, as explicitly stated and arranged by the claim.

Also, independent Claim 1 recites “receiving, at the financial institution the account-holder request to authorize the plurality of third party transactions.” Neofytides relates to a single transaction performed by the account holder and does not disclose that a financial institution receives an account-holder request to authorize a plurality of third party transactions. The banks that are associated with the bank accounts in Neofytides only receive a request from the *account holder* to transfer money to another party via a *single* transaction. There is no disclosure in Neofytides of *multiple* third party transactions *by a third party* on behalf of the account holder or a request to authorize such third party transactions. Neither Neofytides nor Jamison, singly or in combination, disclose forwarding the account-holder request *to a specific third party* to authorize *multiple recurring third-party transactions performed by the specific third party* on behalf of the account holder, as recited in Claim 1

For the above reasons, it is submitted that Claim 1 is allowable over the cited art.

Regarding Claims 2-10, Applicants submit that Claims 2-10 are patentable over the cited art for at least the same reasons as discussed above for Claim 1. Claims 2-10 also recite additional features not taught or suggested in Neofytides or Jamison, either singly or in combination. For example, with respect to Claim 6, col. 4, lines 1-10 of Neofytides was cited as teaching “how a user directs a money transfer request to another individual or entity.” Claim 6 recites “the account-holder requests comprise at least one direct-deposit request to authorize the at least one specific third-party participant to periodically direct deposit funds to the account.”

Applicants can find no such teaching in the cited portions of Neofytides, but rather only a discussion of a one-time transfer of money from one person to another person. In the Office Action, Claim 6 was rejected by citing column 1, line 57 to column 2, line 2 of Neofytides, which states that an account holder may schedule future or recurring transactions. However, there is no mention of authorizing a third-party participant (and not the account holder or the financial institution) to periodically direct deposit funds to the account. Neofytides does not teach “at least one direct-deposit request to authorize the at least one specific third-party participant to periodically direct deposit funds to the account,” as recited in Claim 6. In light of the above, Applicant’s submit that the section 102 rejection of Claim 6, as well as the rejections of all other dependent claims, is improper.

E. Conclusion

In summary, Applicants submit that none of the cited art teach or suggest, either singly or in combination, all of the claim elements recited in Claims 1-35. As such, Applicants submit that the Examiner has not met the initial burden of factually supporting a *prima facie* case of anticipation or obviousness. See § M.P.E.P. §§ 2131 and 2142. Accordingly, it is respectfully submitted that Claims 1-35 are patentable over the cited art and that the rejections should be withdrawn.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 13-4365.

Respectfully submitted,



Date: 3/24/2010

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